

### **Remarks/Arguments:**

In the Office Action dated July 10, 2006 the Examiner rejected Claims 5, 8, 23, 24, 26-28 under 35 U.S.C. §112 ¶1; rejected Claims 5, 8, 18, 21, 23, and 27 under 35 U.S.C. §112 ¶2; rejected Claims 5, 8, 18, 19, 21, 23, 24, 26, 27, and 28 under 35 U.S.C. 103(a) as being unpatentable by Anderson in view of Norman; rejected claims 18, 19, and 21 under 35 U.S.C. 103(a) as being unpatentable over Cushing in view of Anderson; rejected claims 5, 8, 23, 24, and 26-28 under 35 U.S.C. 103(a) as being unpatentable over Cushing in view of Anderson and Shurnick. No other basis of rejection was stated of record.

### **Background of the Law**

In order to establish a proper anticipation under 35 U.S.C. §102, each and every element of the claimed invention must be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The claimed elements must either be inherent or disclosed expressly in the single prior art reference. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988) and must be arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). The absence from the reference of any claimed element necessarily negates anticipation. *Kloster Speedsteel AB. v. Crucible Inc.*, 793 F.2d 1565, 220 USPQ 81 (Fed. Cir. 1986). Anticipation can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433. See also *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) and MPEP §2112.01.

Obviousness under 35 U.S.C. §103 is a question of law based on findings of underlying *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q (BNA) 459, 467, 15 L.Ed. 2d 545, 86 S.Ct. 684 (1966). To establish a prima facie case of obviousness, there must be some teaching, suggestion, or motivation in the prior art to make the specific combination or modification suggested by the Examiner. *In re Raynes*, 7 F.3d 1037, 1039, 28 USPPQ2d 1630, 1631 (Fed. Cir. 1993). Obviousness cannot be established by hindsight combination or modification to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q. 2d 1885, 1888 (Fed. Cir. 1991).

### Summary of Amendments

Applicant has amended Claims 5, 18 and 24 to more clearly state and define subject matter regarded as the invention. Applicant is no longer claiming priority to the earlier filing date.

The amendments do not add new matter to the application. Applicant respectfully submits that the newly submitted Claims define patentable subject matter over the prior art of record in this application.

### Drawings

Applicant has included all reference characters shown in the replacement sheet filed on May 24, 2006. The Examiner is reminded to note Applicant's amendments to the specification which indicated "100" and "200" where to be amended to "1000" and "2000", as on amendment entered on August 8, 2005. If the Examiner is citing specific reference numerals which are not mentioned in the description, the Applicant respectfully requests the Examiner to cite which reference numerals are not mentioned in the description. Otherwise, Applicant has included all reference characters that are currently in the drawings and current specification.

Additionally, Applicant has sufficiently shown the "one way valve" as demonstrated as 17 in Fig. 2. Moreover, in ¶0011 of the originally filed specification, "air enters inner chamber 13 through one way valve 17" when combined with one way valve 17 of Fig. 2, is sufficient to enable of one of ordinary skill in the art of claimed subject matter, i.e. a wafer check valve or a swing check valve. The Examiner is reminded that the breadth of the claims are narrow, the nature of the invention is not complicated, and the state of the art is relatively predictable as to not require undue experimentation to render the application in violation of 35 USC §112.

### Amended Claims 5, 8, 23, 24, and 26-28 Overcome the Rejection Under 35 USC §112 ¶1

Applicant has amended Claims accordingly to contain subject matter, which is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. And applicant has amended Claim 5 to indicate to that "at least one end cap coupled to the second end" as to disclose and enable one cap being coupled to the second end of the pressurizable container 1. Applicant has amended Claim 5 to indicate that the "pump apparatus coupled to the

second end”, as to teach that the pump apparatus is coupled to the second end. Applicant has amended Claim 24 to indicate “a fluid valve is connected to said water conduit” rather than the “one way valve”. Support for “fluid valve” is found in the originally filed specification, ¶0012, “fluid valve 12”. Applicant respectfully submits that the amended claims and description fulfill the 35 USC §112 ¶1 requirements.

**Amended Claims 5, 8, 18, 21, 23, and 27 Overcome the Rejection under 35 U.S.C. §112 ¶2**

Regarding Claim 5, “the restrictive valve” has been cancelled and replaced with “a fluid valve” to have proper antecedent basis. And proper support for the fluid valve can be found in ¶0012, and Figure 2 of applicant’s originally filed specification. Regarding Claim 8, “means for sealing said inlet” is the O-ring 18, which is sandwiched between end cap 20 and tank 1. ¶0011, Fig. 2. Regarding Claim 18, “a manual pump” in line 9 has been deleted. Regarding Claim 19, “means for delivering fluid as a continuous evaporative mist” has proper antecedent basis, as Claim 19 is dependent on Claim 18, which includes the element “a means for delivering fluid as a continuous evaporative mist”. Regarding Claim 27, “means for pressurizing” has been cancelled. Applicant respectfully submits that the amended claims and description fulfill the 35 USC §2 requirements.

**Claims 5, 8, 18, 19, 21, 23, 24, 26, 27, and 28 are patentable over Anderson in view of Norman**

Regarding Claim 5, neither Anderson nor Norman discloses a “misting apparatus for cooling a local area”. Claim 5’s preamble “misting apparatus for cooling a local area” is a limitation because it limits the structure of the claimed invention. Any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application “to gain an understanding of what the inventors actually invented and intended to encompass by the claim.”); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990) (determining that preamble language that constitutes a structural limitation is actually part

of the claimed invention). MPEP §2111.02. The element “misting apparatus for cooling a local area” is a structural limitation because the invention

Anderson discloses a compression sprayer, of the type provided with a tank for receiving and containing a spray solution. Col. 1, lines 15-17. Such compression sprayers are, as construed by one of ordinary skill in the art, are not a misting apparatus. Moreover, Norman is not a misting apparatus. Norman is a water-sprayer and fire-extinguisher. Col. 1, lines 9-12.

Also, Anderson does not disclose a spray nozzle secured to the distal end of the water conduit. While, Norman does not disclose a spray nozzle secured to the distal end of the water conduit.

Finally, Anderson does not disclose a one-way valve. While the Examiner states that Anderson inherently discloses a restrictive valve. Anderson does not disclose such element, but rather discloses a band 35 which surrounds the lower end 36 of the cylinder 14. And Norman does not disclose a one way valve.

Applicant submits that Claims 5, 8, 18, 19, 21, 23, 24, 26, 27, and 28 are patentable over Anderson in view of Norman.

#### **Claims 18, 19, and 21 are patentable over Cushing in view of Anderson**

Cushing does not disclose an apparatus with a means for delivering fluid as a continuous evaporative mist. Examiner is reminded to read the claim language with its ordinary and plain meaning. Spray nozzle 20 does not deliver fluid as a continuous evaporative mist, but rather spray nozzle 20 of Cushing delivers a stream of liquid directed toward the rider’s mouth. Col. 5, lines 28-30, line 33.

Additionally, Anderson does not disclose a seal member, as annular flange 18 in Anderson is spaced from surrounding walls to permit air to enter the cylinder 14. col. 3, lines 33-37, Fig. 4. Such annular flange 18 does not “seal” as seal member 18 does, i.e. cup packing 17 of the piston does not contacts interior wall 33 of the cylinder 14, where flange 18 of the packing 17 is spaced from the surrounding walls. Col. 3, lines 29-33. Therefore, Anderson does not contain the limitation of a “seal member” of Claim 18 and does not contain each and every limitation to render Claim 18 obvious.

Finally, there is no motivation to combine Cushing and Anderson. Anderson relates to tank compression sprayers and removable pump assemblies, Col. 1, lines 15-17, while Cushing

is water pump mountable on a bicycle, col. 1, and lines 6-8. Cushing operates with pleated bellows 40 to force air past first check valve 78 into a chamber 86 that hold compressed air, which then goes through a second check valve 84 and then into a container 16. Col. 5, lines 10-20. Anderson operates with an elastic band 35 with slots 37 provided under protrusion 27 and above flange 30, where upstroke of a plunger causes band 35 to cover and seal the ports 37 against reverse fluid flow. Such operative mechanisms are different and provide no desirability to combine the references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP §2143.01. Moreover, there is a teaching away in Anderson, which provides that protrusion 26 permits free air to enter cylinder 14 at the top of each upstroke of the plunger, which is different than an air pump, which requires a partial vacuum in the cylinder in order that atmospheric air may enter into they cylinder. Col. 4, lines 72-75, Col. 5, lines 1-5. Such partial vacuum is clearly provided in Cushing with the chamber 86.

Applicant submits that Claims 18, 19, and 21 are patentable over Cushing in view of Anderson.

**Claims 5, 8, 23, 24, and 26-28 are patentable over Cushing in view of Anderson and Shurnick**

Cushing does not disclose an apparatus with a means for delivering fluid as a continuous evaporative mist. Examiner is reminded to read the claim language with its ordinary and plain meaning. Spray nozzle 20 does not deliver fluid as a continuous evaporative mist, but rather spray nozzle 20 of Cushing delivers a stream of liquid directed toward the rider's mouth. Col. 5, lines 28-30, line 33.

Applicant submits that Claims 5, 8, 23, 24, and 26-28 are patentable over Cushing in view of Anderson and Shurnick.

**Summary**

Accordingly, Applicant submits that the pending claims are patentably distinct from and over the art cited and of record. Favorable reconsideration of the rejection of the pending claims is solicited.

This Amendment Letter is being concurrently filed with a Transmittal Letter that includes a claim fee calculation and any applicable requests for extension of time, which may be required for the proper presentation and consideration of the present amendments. While no additional fees other than those stated in the Transmittal Letter are believed to be required in connection with the filing of this amendment, the Director is hereby authorized to deduct any such fees from Deposit Account No. 18-2000 of which the undersigned is an authorized signatory.

Applicant solicits the Examiner's favorable reconsideration of the rejections and objections of record and submits that the presently pending claims are allowable over the art cited and of record, and therefore requests that the currently pending claims be allowed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. Peter Paredes', is written over a horizontal line.

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